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10/065,397	10/11/2002	Dante Monteverde	33983/400200	2789

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EXAMINER
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OSBORNE, LUKE R

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/065,397

Applicant(s)

MONTEVERDE, DANTE

Examiner

Luke Osborne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/28/03, 11/22/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because page 13 of the application states "Figures" as the title and no figures are on the page. The examiner suggests this otherwise blank page be stricken from the record.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD OF ASSIGNING WEB SITES OR PAGES TO A CATEGORY.

3. The use of the trademark Yahoo!, Google, and Excite has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the meta-tag field " in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. Further the recitation of "the meta-tag field of said internet site" also renders the claim indefinite. Applicant's definition of Internet site in paragraph 0002 refers to a logical grouping of relevant Internet pages. This definition cannot support the physical meta-tag description as claimed.

In the interest of compact prosecution, the examiner presumes that "the meta-tag field of said internet site" is the meta-tag of the page that loads when the domain is accessed through a web browser (e.g. home page). The examiner also presumes that Internet site and Web site are synonymous as is common in the art and based on the following definition from the Microsoft Computer Dictionary 3<sup>rd</sup> Edition, Web site: A group of related HTML documents and associated files, scripts, and databases that is served up by a HTTP server on the World Wide Web...

Claim 9 recites the limitation "the meta-tag field" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

In the interest of compact prosecution, the examiner presumes that "the meta-tag field" refers to the contained meta-tag field in the Internet page that is being assigned.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,178,419 to Legh-Smith et al. in view of U.S. Patent No 5,745,899 to Burrows. Please observe that unless otherwise noted cited references refer to the primary reference of Legh-Smith et al.

Referring to claim 1, Legh-Smith teaches a method of assigning keywords to Internet page as claimed. See Figures 1-4 and the corresponding portions of Legh-Smith's specification, for this disclosure. Refer specifically to Figure 3 and the corresponding portions of the disclosure for the claimed invention. In particular Legh-Smith teaches a method of assigning keywords to an Internet site or Internet page, comprising the steps of:

Providing a topical category database [item 300, Column 4, lines 66-67, Column 5, line 1], said topical category database contains at least one predefined topical category [... comprising headings and categories for inclusion in the database 112. (Fig 2, item 200)];

Assigning at least one keyword to said predefined topical categories [step 302, a list of keywords is generated for each of the categories for inclusion in the category list (Column 5, lines 3-5)];

Providing an Internet site and Internet page database [112], said Internet site and Internet page database contains information relative to at least one Internet site or Internet page [Fig. 4, Column 5, lines 45-48];

Assigning each said Internet page to at least one said predefined topical category [the list of URLs is cross-referenced back with the original description of categories and keywords (Column 5, lines 45-49)], thereby creating as page assigned topical category; and assigning each said Internet page [URL] at least one keyword contained within said keyword list [item 302] for said page assigned topical category.

Legh-Smith does not teach that keyword and category assignments are made to an "Internet site". However, Legh-Smith does teach that "the terms "pages" and "documents" both refer to a compilation of data stored at a single location, for example in the WWW...[Web site]".

Burrows discloses a system similar to Legh-Smith for indexing information from sites on a network [Internet]. See Figure 1 and the corresponding portions of Burrows specification for this disclosure. Furthermore, Burrows discloses, "Other indexable attributes can include... host (site) names e.g., "digital.com"..." [Paragraph 82, lines 4-5].

It would have been obvious to one of ordinary skill in the art at the time applicants invention was made to incorporate Burrows' site indexing ability into the

method of Legh-Smith. One would have been motivated to do so because of the suggestions provided by Legh-Smith, as described above.

Referring to claim 2, the method of Legh-Smith in view of Burrows as applied to claim 1 above discloses the invention as claimed. See Figure 3 and the corresponding portions of Legh-Smith's specification for this disclosure. Legh-Smith v. Burrows teaches the method of claim 1, as above, "further comprising the step of assigning each said Internet page to at least one said predefined topical category [the list of URLs is cross-referenced back with the original description of categories and keywords (Column 5, lines 45-49)], thereby creating page assigned topical category" as claimed.

Referring to claim 3, the method of Legh-Smith in view of Burrows as applied to claim 2 above discloses the invention as claimed. See Figure 3 and the corresponding portions of Legh-Smith's specification for this disclosure. Legh-Smith v. Burrows teaches the method of claim 2, as above, "further comprising the step of assigning each said Internet page [URL] at least one keyword contained within said keyword list [item 302] for said page assigned topical category" as claimed.

Referring to claim 4, the method of Legh-Smith in view of Burrows as applied to claim 1 above discloses the invention as claimed. See Figure 4 and the corresponding portions of Legh-Smith's specification for this disclosure. Legh-Smith v. Burrows teaches the method of claim 1, as above, "wherein each of said predefined topical categories has a title [heading] and a brief synopsis description [associated information (Column 5, lines 5-8)]" as claimed.

Referring to claim 5, the method of Legh-Smith in view of Burrows as applied to claim 4 above discloses the invention as claimed. See Figure 3 and the corresponding

portions of Legh-Smith's specification for this disclosure. Legh-Smith v. Burrows teaches the method of claim 1, as above, "assigning at least one keyword to said predefined topical category [Once (keywords are) provided for each of the categories] based on relatedness [associated information] between said keyword and said predefined topical category [Column 5, line 12, Column 5, lines 5-8]" as claimed.

Referring to claim 6, the method of Legh-Smith in view of Burrows as applied to claim 2 above discloses the invention as claimed. See Figure 3 and the corresponding portions of Legh-Smith's specification for this disclosure. Legh-Smith v. Burrows teaches the method of claim 2, as above, "comprising the step of adding any keywords previously assigned to said Internet site to said keyword list [Step 316] for said site assigned topical category [after steps 316, 320, report 322 contains filtered out URL's to allow periodic checks to be carried out to ensure that good information is not being rejected]" as claimed.

Referring to claim 7, the method of Legh-Smith in view of Burrows as applied to claim 6 above discloses the invention as claimed.

Referring to claim 8, the method of Legh-Smith in view of Burrows as applied to claim 1 above discloses the invention as claimed. See Figure 3 and the corresponding portions of Legh-Smith's specification for this disclosure. Legh-Smith v. Burrows teaches the method of claim 1, as above. In particular Legh-Smith v. Burrows teaches assigning each said Internet site to at least one said predefined topical category, thereby creating a page assigned topical category, comprising the steps of:



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reviewing any previously assigned keywords contained within the meta tag field of said Internet site [step 316, the list of URLs (which as mentioned above is arranged by keyword)];

matching said previously assigned keywords to keywords contained within said keyword list[is cross-referenced back with the original description of categories and keywords, generated in step 302];

assigning said Internet page to the predefined topical category whose keyword list contains matching keywords [to identify those URLs which are candidates for each category].

Referring to claim 9, the method of Legh-Smith in view of Burrows as applied to claim 2, and claim 8 above discloses the invention as claimed.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,701,314 to Conover et al. is considered particularly pertinent to applicant's claimed invention. Specifically it discloses a system to index and catalog digital information.

The remaining prior art made of record is considered pertinent to applicant's disclosure, and/or portions of applicant's claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Osborne whose telephone number is 703-308-7911. The examiner can normally be reached on 8-4:30.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

LRO  
8/17/04



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